

REMARKS

With the foregoing amendment claims 1-6 and 21-34 are pending in the application. Claims 21-34 have been added. Claims 1 and 26 are in independent form. No new matter has been added by the amendments. Applicant respectfully requests reconsideration of the Rejections/Objections, which are discussed below.

Rejection of Claims 1-6 Under 35 U.S.C. 103

Claims 1-6 stand rejected under 35 U.S.C. 103 as being unpatentable over Cook, Jr. (US 6,248,061) (hereafter "Cook"). Applicant respectfully disagrees.

Claim 1

Claim is patentable over Cook because (a) Cook does not teach or suggest all of the features of claim 1 and (b) there is no suggestion or motivation to modify the apparatus disclosed in Cook to achieve the claimed invention.

First, Cook does not teach or suggest all of the features of claim 1. For example, Cook does not teach or suggest a "guide tube," let alone two "guide tubes," as is required by claim 1. Cook discloses a "suction tube 81" (*see Cook, col. 5, lines 25-67*). A "suction tube" is not a "guide tube." To contend that a "suction tube" and a "guide tube" are the same is to completely ignore the words "suction" and "guide." It is wrong for the Office to ignore positive claim language. A "suction tube" is a device configured and arranged to be connected to a vacuum/suction source and is configured and arranged to remove debris. *See Cook, col. 5, lines 63-65* ("Once connected to the suction/vacuum source 92, any debris 88, such as blood, vomit, or the like, can be removed from the patient's airway 54."). In contrast, a "guide tube" is a device configured and arranged to direct elongate matter (e.g., an aspiration tube or other element) that is inserted into the guide tube. Accordingly, Cook does not teach or suggest a "guide tube." For this reason alone, the rejection of claims 1-6 should be withdrawn.

Moreover, claim 1 explicitly states, “said first and second guide tubes [are] constructed and arranged to direct tubes extended therethrough” The Office does not even contend that the “suction tube” disclosed in Cook is “constructed and arranged to direct tubes extended therethrough,” as is required by claim 1. Rather, the Office states, “[the] suction tube 81 is ... constructed and arranged to direct suction extended therethrough” *Office Action*, p. 3 (emphasis added). The Office appears to be equating “suction” with a “tube.” However, a tube is a physical element, whereas “suction” is merely “a force.”¹ Accordingly, Cook does not teach or suggest a tube constructed and arranged to direct a “tube” extended therethrough, as is required by claim 1. For this additional reason, the rejection of claims 1-6 should be withdrawn.

Second, even if we were to assume for the sake of argument that Cook discloses a “guide tube” that is “constructed and arranged to direct tubes extended therethrough,” claim 1 would still be patentable over Cook because: claim 1 requires two guide tubes, Cook only discloses a single suction tube, and there is no motivation or suggestion to modify the apparatus of Cook to include two suction tubes.

It is well settled that in order to establish a prima facie case of obviousness “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference” M.P.E.P. 2143 - Basic Requirements of a *Prima Facie* Case of Obviousness. In this case, there is no suggestion or motivation to modify the Cook reference to include two suction tubes.

The Office does not even contend that there is a suggestion or motivation to modify Cook. Rather, the Office merely states, “duplicating the components of a prior art device is a design consideration within the skill of the art [citations omitted]. Accordingly, it would have been an obvious matter of design choice to provide the blade 60 of Cook, Jr. with a second suction tube 81.” *Office Action*, p. 3. But, “the fact that the claimed invention is

¹ See *The American Heritage® Dictionary of the English Language, Fourth Edition* (<http://dictionary.reference.com/search?r=1&q=suction>) (defining “suction” as “a force that causes a fluid or solid to be drawn into an interior space or to adhere to a surface because of the difference between the external and internal pressures.”)

within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.” M.P.E.P. 2143.01(III). Accordingly, because the Office has not articulated any suggestion or motivation to modify Cook to include two suction tubes, the Office has not established a *prima facie* case of obviousness.

The reason the Office has not articulated any suggestion or motivation to modify Cook to include two suction tubes is simply because there is no suggestion or motivation found in either Cook itself or the knowledge of persons of ordinary skill in the art. In fact, Cook implicitly teaches away from adding an additional suction tube to the disclosed device. Cook explicitly states that an advantage of the device is that the device is “sleek or minimal.” *Cook, col. 5, line 34*. Adding a second suction tube 81 to the device would necessarily make the device bulkier. According to Cook, “bulkier laryngoscope devices may not only obstruct the airway of a patient 55 but are also more difficult to insert into the proper positions.” *Cook, col. 5, lines 43-46*. Thus, Cook explicitly teaches that sleek or minimal is preferred to bulky. Hence, Cook discourages adding additional components to the device because adding additional components would only make the device bulkier. Accordingly, not only has the Office failed to articulate a reason as to why there is a suggestion or motivation to modify Cook, but also Cook itself teaches away from the modification proposed by the Office. In short, the Office has not and cannot establish a *prima facie* case of obviousness. For this additional reason, the rejection of claims 1-6 should be withdrawn.

Claim 2

Claim 2 depends from claim 1 and, thus, is patentable for at least the same reasons given above. Moreover, claim 2 is patentable over Cook because there is not suggestion or motivation to modify the device of Cook to include two suction tubes, where one of the tubes is curved and the other is straight.

As with claim 1, the Office does not articulate any reason for why there is a suggestion or motivation to modify Cook to achieve the invention of claim 2. Rather, the Office merely states, “since the suction tube 81 follows the contour of the blade 60, which

has both curved portion 62 and a straight portion ..., it follows that one tube could be designated as substantially straight and the other could be designated as curved.”

But, as stated above, it is not sufficient to base a claim of obviousness solely on the fact that the claimed invention is within the capabilities of one of ordinary skill in the art. Thus, the mere fact that one suction tube could be straight while the other could be curved is not in and of itself sufficient to hold claim 2 obvious. There must be more. There must be a “motivation or suggestion” to modify Cook to include a straight suction tube and a curved suction tube. There is no such motivation.

As discussed above, Cook teaches that it is advantageous to have a “sleek” or “minimal” device. If one were to modify the device of Cook so that one suction tube is curved, while the other is straight, then the resulting device would not be sleek or minimal. Additionally, it is not at all clear that it is even possible to include a straight suction tube 81 in the device disclosed by Cook.

The suction tube 81 disclosed in Cook must function to remove blood and vomit from a patient’s airway. Thus, the end of the tube 81 must be positioned near the airway. That is why Cook discloses that “preferably, the suction end 82 of the suction tube 81 is positioned approximately 2 centimeters from the distal end 64 of the blade portion 62.” *Cook, col. 5, lines 65-67*. According to Cook, “this enables the suction tube 81 to have a sleek profile and minimal structure, which prevents the laryngoscope blade 60 from improperly obstructing the patient’s airway.” *Cook, col. 5, line 67 to col. 6, line 2*. Although Cook further states, “the precise positioning of the suction tube 81 may vary and that 2 centimeters is the preferred positioning,” *col. 6, lines 4-8*, it is clear that the suction end 82 of the suction tube 81 must be near the distal end 64 of the blade portion 62, otherwise, the suction end 82 would not be close enough to the airway to suck blood and vomit from the airway. Further, it is also clear that if Cook were to add a second suction tube 81, it would only make sense to position the adaption end 84 of the second suction tube 81 next to the adaption end 84 of the first suction tube 81 because both suction tubes must be connected to a vacuum/suction source.

Applicant fails to see how one could modify Cook to include a straight suction tube 81 that has a suction end 82 adjacent or near to the distal end 64 of blade portion 62 and

adapter end 84 that is positioned next to the adapter end 84 of the original suction tube 81. Perhaps it could be done, but such a resulting device would not be “sleek” or “minimal,” which Cook discloses as being significant feature of his invention. In short, it would be difficult, if not impossible, to add a straight suction tube 81 to the device because the device is curved and it is advantageous for the tube to follow the curvature of the device.

For these additional reasons, the rejection of claim 2 should be withdrawn.

Claims 3-6

Claims 3-5 depend from claim 1 and, thus, are patentable for at least the same reasons given above.


New Claims

New Claims 21-34 are added. Claims 21-25 depend from claim 1. Claim 26 is independent. Claim 26 is patentable over Cook because Cook does not teach or suggest “a first guide means for guiding a first aspiration tube to a patient’s laryngeal gutter, said first guide means being secured to said upper surface of said elongated blade,” as is required by claim 26. Claims 27-34 depend from claim 26.

CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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